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DEC 04 2009

OFFICE OF PETITIONS

In re Application of :
Lawrence A. Shimp et al. : DECISION ON APPLICATION
Application No. 10/614,448 : FOR PATENT TERM ADJUSTMENT
Filed: July 7, 2003 :
Attorney Docket No.285-180 PCT:
CIIP

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)" filed September 9, 2009. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred sixty-five (165) days to two hundred seventy-three (273) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct patent term adjustment determination at the time of the mailing of the notice of allowance is **273 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 9, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 165 days. On September 9, 2009, applicant timely submitted the instant application for patent term adjustment¹.

¹ The Office records show that the issue fee was also received on September 9, 2009.

Applicant disputes the period of adjustment of 479 days entered pursuant to 37 CFR 1.702(a)(1) and 1.703(a)(1) for Office delay in failing to mail the first Office action under 35 U.S.C. 132 no later than 14 months after the actual filing date of the application. Applicant asserts that 479 days of patent term adjustment under 37 CFR 1.702(a)(1) and 1.703(a)(1) is in error because the Office failed to appreciate that the Restriction Requirement mailed on December 30, 2005, was vacated by the Restriction Requirement mailed April 17, 2006. Applicant contends that the April 17, 2006, mailing date of the Restriction Requirement should have been used to calculate the period of adjustment pursuant to 37 CFR 1.702(a)(1) and 1.703(a)(1).

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 154(b)(1)(A)(i) provides that:

— Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after—

(I) the date on which an application was filed under section 111(a) of this title; or

(II) the date on which an international application fulfilled the requirements of section 371 of this title[.]

37 CFR 1.702 provides that:

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the

application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application[.]

37 CFR 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first[.]

OPINION

Applicants' arguments and evidence have been considered and are well taken. In light of the application history, it has been determined that the period of adjustment for Office delay pursuant to 37 CFR 1.702(a)(1) is 587 days. The Office mailed a Restriction Requirement on December 30, 2005. On April 17, 2006, the Office mailed another Restriction Requirement that stated, in pertinent part, that:

1. Examiner appreciates courtesy extended by applicant's representative to point out to the Examiner in a telephone interview on 23 January 2006 that the Election Requirement in Office Action mailed 30 December 2005 does not encompass all the claims presented for examination in Applicant's Preliminary amendment filed 09 October 2003.

2. In view of the telephonic interview cited, *supra*, Examiner herewith vacates the Election/Restriction Requirement in the Office action of 30 December 2005. A new Office Action follows.

Excerpt taken from Restriction Requirement mailed April 17, 2006, pg. 3.

As the Restriction Requirement mailed December 30, 2005, was vacated and a new Restriction Requirement mailed on April 17, 2006, the Restriction Requirement mailed April 17, 2006, is the Office action under 35 U.S.C. 132 that should have been used in calculation of the period of adjustment under 37 CFR 1.702(a)(1). Accordingly, the period of adjustment under 37 CFR 1.702(a)(1) of 479 days will be removed and period of 587 days will be entered.

The \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to the patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

Day : Thursday
Date: 12/3/2009

PALM INTRANET

Time: 16:50:31

PTA Calculations for Application: 10/614448

Application Filing Date:	07/07/2003	PTO Delay (PTO):	479
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	314
Post-Issue Petitions:	0	Total PTA (days):	273
PTO Delay Adjustment:	108		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
103	12/03/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	587		
102	12/03/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		479	
91	06/09/2009	MAIL NOTICE OF ALLOWANCE			
87	05/15/2009	FILING RECEIPT - CORRECTED			
85	05/14/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
84	05/14/2009	CASE DOCKETED TO EXAMINER IN GAU			
83	05/14/2009	ISSUE REVISION COMPLETED			
82	05/14/2009	DOCUMENT VERIFICATION			
81	10/01/2003	REFERENCE CAPTURE ON IDS			
80	10/01/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
79	05/11/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
78	05/08/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
77	05/06/2009	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
76	05/14/2009	EXAMINER'S AMENDMENT COMMUNICATION			
75	05/11/2009	NOTICE OF ALLOWABILITY			
74	02/24/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
73	03/06/2009	DATE FORWARDED TO EXAMINER			
72	02/24/2009	RESPONSE AFTER NON-FINAL ACTION		119	68
71	02/24/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
70	02/17/2009	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			

69	12/04/2008	DATE FORWARDED TO EXAMINER			
68.1	10/28/2008	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
68	10/28/2008	RESPONSE AFTER NON-FINAL ACTION			
67	07/28/2008	MAIL NON-FINAL REJECTION			
66	07/21/2008	NON-FINAL REJECTION			
65	04/18/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
64	04/18/2008	REFERENCE CAPTURE ON IDS			
62	04/18/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		17	60
61	05/09/2008	DATE FORWARDED TO EXAMINER			
60	04/01/2008	RESPONSE AFTER NON-FINAL ACTION		5	58
59	04/18/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
58	12/27/2007	MAIL NON-FINAL REJECTION			
57	12/21/2007	NON-FINAL REJECTION			
56	10/09/2007	DATE FORWARDED TO EXAMINER			
55	09/26/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
54	10/09/2007	DATE FORWARDED TO EXAMINER			
53	09/26/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
52	10/09/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
51	09/26/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
50	07/27/2007	MAIL FINAL REJECTION (PTOL - 326)			
49	07/23/2007	FINAL REJECTION			
48	10/01/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
47	10/01/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
46	05/09/2007	DATE FORWARDED TO EXAMINER			
45	05/03/2007	RESPONSE AFTER NON-FINAL ACTION		143	40
44	04/03/2007	MAIL NOTICE OF INFORMAL OR NON- RESPONSIVE AMENDMENT			
43	12/28/2006	CORRESPONDENCE ADDRESS CHANGE			
42	12/29/2006	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
41	12/28/2006	DATE FORWARDED TO EXAMINER			

40.1	12/11/2006	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
40	12/11/2006	RESPONSE AFTER NON-FINAL ACTION		30	37
39	12/11/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
38	10/12/2006	CASE DOCKETED TO EXAMINER IN GAU			
37	08/11/2006	MAIL NON-FINAL REJECTION			
36	08/07/2006	NON-FINAL REJECTION			
35	05/24/2006	DATE FORWARDED TO EXAMINER			
34	05/19/2006	RESPONSE TO ELECTION / RESTRICTION FILED			
33	04/17/2006	MAIL NOTICE OF WITHDRAWN ACTION			
32	04/17/2006	MAIL RESTRICTION REQUIREMENT			
31	01/23/2006	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
30	04/14/2006	REQUIREMENT FOR RESTRICTION / ELECTION			
29	04/14/2006	LETTER WITHDRAWING / VACATING OFFICE ACTION			
22	12/30/2005	MAIL RESTRICTION REQUIREMENT	479		-1
21	12/27/2005	REQUIREMENT FOR RESTRICTION / ELECTION			
20	06/28/2005	CASE DOCKETED TO EXAMINER IN GAU			
19	08/12/2004	CORRESPONDENCE ADDRESS CHANGE			
18	01/14/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
17	10/09/2003	PRELIMINARY AMENDMENT			
16	01/14/2004	CASE DOCKETED TO EXAMINER IN GAU			
15	12/04/2003	APPLICATION RETURN FROM OIPE			
14	12/04/2003	APPLICATION RETURN TO OIPE			
13	12/04/2003	APPLICATION DISPATCHED FROM OIPE			
12	12/04/2003	APPLICATION IS NOW COMPLETE			
11	10/30/2003	ADDITIONAL APPLICATION FILING FEES			
10	10/30/2003	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
9	07/07/2003	CLAIM PRELIMINARY AMENDMENT			
8	10/01/2003	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
6	09/17/2003	CASE CLASSIFIED BY OIPE			
5	09/17/2003	CLEARED BY OIPE CSR			
4	09/17/2003	CASE CLASSIFIED BY OIPE			

3	09/17/2003	CLEARED BY OIPE CSR			
2	09/06/2003	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/07/2003	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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